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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/610,933	06/30/2003	Josh Hogan	10002759.4	2541

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EXAMINER

CHU, KIM KWOK

ART UNIT PAPER NUMBER

2653

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/610,933

Applicant(s)

HOGAN, JOSH

Examiner

Kim-Kwok CHU

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/542,404.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,631,108. Although the conflicting claims are not identical, they are not patentably distinct from each other.

3. With respect to the present claim 7, its subject matters are also claimed in the '108 patent. For example:

(a) as in claim 7, writing a first data set, with a write timing, at an area on an optical disc that has spatial features that distort an analog read data signal, the distortion varying

as a function of write timing (claim 1, lines 1-5 of the '108 patent);

(b) as in claim 7, writing a second data set, with the write timing, at an area on the optical disc that has spatial features that distort an analog read data signal, the distortion varying as a function of write timing (claim 1, lines 6-9 of the '108 patent);

(c) as in claim 7, reading the first data set and the second data set from the optical disc (claim 1, lines 10 and 11 of the '108 patent);

(d) as in claim 7, determining a first read error rate for the first data set, and a second read error rate for the second data set (claim 1, lines 12-14 of the '108 patent);

(e) as in claim 7, comparing the first and second error rates (claim 1, line 19 of the '108 patent); and

(f) as in claim 7, adjusting the write timing based on the comparison of the first and second error rates (claim 1, last two lines of the '108 patent).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

5. Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Narumi et al. (U.S. Patent 6,031,800).

Narumi teaches a method of adjusting write timing for an optical disc having all of the steps as recited in claims 1-4. For example, Narumi teaches the following:

(a) as in claim 1, writing a data set with a write timing (Fig. 1);

(b) as in claim 1, writing a data set at an area on an optical disc that has spatial features (Figs. 28 and 29; guide groove 2302 and pit train 2502 are spatial features);

(c) as in claim 1, the spatial features that distort an analog read data signal (Figs. 28 and 29; column 1, lines 42-45);

(d) as in claim 1, the distortion varying as a function of write timing (Fig. 1; column 1, lines 42-45);

(e) as in claim 1, the data set has a characterized read error rate as a function of write timing at the area that has the spatial features (Fig. 6A; column 8, line 25);

(f) as in claim 1, reading the data set from the optical disc 113 (Fig. 1);

(g) as in claim 1, determining a read error rate for the data set (column 8, line 25);

(h) as in claim 1, adjusting the write timing based on the read error rate of the data set (Fig. 4; Column 8, lines 23-25 and 49-52) and the characterized read error rate as a function of write timing (Figs. 6A and 6B);

(i) as in claim 2, observing whether the error rate increases when write timing is shifted in one direction (Figs. 6A and 6B);

(j) as in claim 3, observing whether the error rate decreases when the write timing is shifted in one direction (Figs. 6A and 6B); and

(k) as in claim 4, repeating the steps of writing a data set, reading the data set, and determining a read error rate for the data set, multiple times (Figs. 6A and 6B; column 10, table 1).

6. Claims 5-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by Narumi et al. (U.S. Patent 6,031,800).

Narumi teaches a method of adjusting write timing for an optical disc having all of the steps as recited in claims 5-7. For example, Narumi teaches the following:

(a) as in claim 5, writing a data set with a write timing (Fig. 1);

(b) as in claim 5, writing a data set at an area on an optical disc that has spatial features (Figs. 28 and 29; guide groove 2302 and pit train 2502 are spatial features);

(c) as in claim 5, the spatial features that distort an analog read data signal (Figs. 28 and 29; column 1, lines 42-45);

(d) as in claim 5, the distortion varying as a function of write time (Fig. 1; column 1, lines 42-45);

(e) as in claim 5, reading the data set from the optical disc (Fig. 1);

(f) as in claim 5, determining a first read error rate for the data set; adjusting the write timing (column 8, line 25; step 205, column 6, lines 16-20);

(g) as in claim 5, writing the data set at the area on the optical disc that has spatial features; reading the data set from the optical disc (column 8, line 25; step 205, column 6, lines 16-20);

(h) as in claim 5, determining a second read error rate for the data set (Fig. 2, step 205; column 6, lines 16-35);

(i) as in claim 5, selecting a lowest read error rate among the first and second read error rates (column 8, lines 47-58); and

(j) as in claim 5, choosing a write timing corresponding to the lowest read error rate (column 8, lines 47-58).

7. Claim 6 have limitations similar to those treated in the above rejection, and is met by the reference as discussed above.

8. Claim 7 have limitations similar to those treated in the above rejection, and is met by the reference as discussed above. Claim 7 however also recites the following limitation:

(a) writing a predetermined first data set and second data set (column 6, lines 19-25).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gushima et al. (6,721,255) is pertinent because Gushima teaches a recording system using a recording pulse with corrected edge position.

Shoji et al. (6,359,846) is pertinent because Shoji teaches a recording apparatus having a position adjusting pattern generator.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C.
20231 Or faxed to:

(703) 872-9306 (for formal communications intended for
entry. Or:

(703) 746-6909, (for informal or draft communications,
please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park
II, 2021 Crystal Drive, Arlington. VA., Sixth Floor
(Receptionist).

Any inquiry of a general nature or relating to the status
of this application should be directed to the Group
receptionist whose telephone number is (703) 305-4700.

Any inquiry concerning this communication or earlier
communications from the examiner should be directed to Kim CHU
whose telephone number is (703) 305-3032 between 9:30 am to
6:00 pm, Monday to Friday.

Ke 7/28/04
Kim-Kwok CHU
Examiner AU2653
July 28, 2004

(703) 305-3032

A. J. HEINZ
PRIMARY EXAMINER
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A. J. Heinz